

**REMARKS**

Claims 1-22, 24-59, 61-80 and 84-88 are pending in this application. Non-elected claims 1-22, 24-59, 61-73, 76-78, 84, 87 and 88 are withdrawn from consideration by the Examiner. By this Amendment, claims 1, 24, 37, 61, 74-76, 79, 84 and 85 are amended and claims 23, 60 and 81-83 are canceled. Support for the amendments to the claims may be found, for example, at paragraphs [0021] and [0028]. No new matter is added. In view of the following remarks, reconsideration and allowance are respectfully requested.

**I. Rejection Under 35 U.S.C. §103**

The Office Action rejects claims 74, 75, 79-83, 85 and 86 under 35 U.S.C. §103 as allegedly having been obvious over Okada in view of Simon and further in view of Reinehr. By this Amendment, claims 81-83 are canceled, thereby rendering their rejections moot. As to the remaining claims, Applicants respectfully traverse the rejection.

Claims 74, 75, 79, 80, 85 and 86 are directed to a method of making up dark skin by applying a composition comprising "at least one coloring agent having reflectance of a yellow or orange coloration in a range from 550 to 675 nm and reflective particles comprising at least one nacre." However, the applied references, alone or in combination, fail to teach or suggest the claimed method of applying a composition comprising the claimed combination.

Because the applied references, alone or in combination, would not have produced the subject matter of claims 74, 75, 79, 80, 85 and 86, the applied references, alone or in combination, would not have rendered claims 74, 75, 79, 80, 85 and 86 obvious.

**A. The Applied References, Alone or in Combination, Fail to Teach or Suggest the Claimed Composition**

The applied references, alone or in combination, fail to teach or suggest a composition comprising "at least one coloring agent having reflectance of a yellow or orange coloration in a range from 550 to 675 nm and reflective particles comprising at least one nacre," as recited

by the pending claims. Therefore, the pending claims would not have been rendered obvious by the applied references, alone or in combination.

1. Simon

Simon teaches generally making up skin, lips and/or exoskeletal appendages based on the use of a particular goniochromatic colorant. See column 2, lines 32-35. However, the composition used in making up skin as taught by Simon does not comprise the combination of "at least one coloring agent having reflectance of a yellow or orange coloration in a range from 550 to 675 nm and reflective particles comprising at least one nacre," as recited by the claims. In fact, Simon merely discloses that the nacreous pigments may be an *optional* component. See column 5, lines 18-25 ("The second (or first) composition of the invention may comprise one or more monochromatic colorants selected from monochromatic dyes, monochromatic pigments and nacreous pigments...According to the invention, the assembly of these colorants must exhibit one of the colors of the goniochromatic colorant or of the assembly of the goniochromatic colorants")(emphasis added). Thus, Simon teaches that the pigment source of the make up composition is the goniochromatic colorant, while nacreous pigments may merely be added to the composition. Moreover, Simon does not describe an example of a make up composition comprising the nacreous pigments. Accordingly, Simon fails to teach or suggest making up dark skin by applying a composition comprising "at least one coloring agent having reflectance of a yellow or orange coloration in a range from 550 to 675 nm and reflective particles comprising at least one nacre," as recited by the claims.

2. Reinehr

Reinehr is silent as to the composition comprising "at least one coloring agent having reflectance of a yellow or orange coloration in a range from 550 to 675 nm and reflective particles comprising at least one nacre," as recited by the claims. In fact, page 8 of the Office Action relies on Reinehr merely for its teaching of "the use of a polymeric carrier material

treated with a fluorescent whitening agent," but not for teaching or suggesting the composition used in the claimed methods.

### 3. Okada

Likewise, Okada is silent as to the composition comprising "at least one coloring agent having reflectance of a yellow or orange coloration in a range from 550 to 675 nm and reflective particles comprising at least one nacre," as used in the claimed methods. Page 6 of the Office Action relies on Okada's disclosure of "treated pigments" as allegedly teaching a "coloring agent" and Okada's disclosure of "iron oxide" as allegedly teaching "reflective particles." However, because Okada is silent as to a composition comprising "at least one coloring agent having reflectance of a yellow or orange coloration in a range from 550 to 675 nm and reflective particles comprising at least one nacre," as used in the claimed methods, Okada fails to teach or disclose at least this limitation.

Moreover, Applicants respectfully submit that the Office Action's allegation that the limitation "said composition having a hue angle from 40° to 70° and a saturation C\* ranging from 20 to 50," as recited in claim 74, and the limitation "said composition having a reflectance ranging from 10% to 45% in the range of from 600 to 680 nm" as recited in claim 75, are inherent characteristics of Okada's composition, is unsubstantiated.

As described in the present specification in paragraphs [0008] and [0009], a problem that occurs when applying a composition of foundation type for making up dark skin is that, when it is applied to a user's skin, it is difficult to create a natural look, while minimizing an undesired grayish-colored appearance. Such grayish-colored effect may be attributable to the presence of white particles in the foundation. Accordingly, selecting a composition based on its colorimetric characteristics, such as hue angle, saturation, and reflectance, both: 1) promotes the selection of a composition that is natural-looking when applied on the user's skin; and 2) helps prevent the selection of a composition that creates a grayish and dull

appearance. By selecting and applying a composition having a hue angle  $h$  ranging from  $40^\circ$  to  $70^\circ$ , and a saturation  $C^*$  ranging from 20 to 50, as required by claim 74, or a composition having a reflectance ranging from 10% to 45% in the range of from 600 to 680 nm, as required by claim 75, dark skin can be made up to create an evenness in color without a grayish appearance. However, as discussed below, and as admitted by the Office Action on page 6, Okada does not describe making up dark skins, as recited by the claims ("Okada et al. do not teach specifically teach a method for making up dark skin or lightening dark skin"). Therefore, contrary to the Office Action's assertion, Okada's composition does not inherently possess the characteristics of "said composition having a hue angle from  $40^\circ$  to  $70^\circ$ , and a saturation  $C^*$  ranging from 20 to 50 as recited in claim 74 and the limitation "said composition having a reflectance ranging from 10% to 45% in the range of from 600 to 680 nm" as recited in claim 75. Instead, the recited ranges of the parameters effectively result in a limitation of the scope of the pending claims.

**B. The Applied References, Alone or in Combination, Would Not Have Taught or Suggested Making Up Dark Skin**

Claims 74, 75, 79, 80, 85 and 86 are directed to a method for making up dark skin, wherein "the dark skin has a mean lightness  $L^*$  of less than 55, as measured on a forehead, cheekbones and chin, in a CIE 1976 colorimetric space." However, the applied references, alone or in combination, fail to teach or suggest at least this limitation. Accordingly, the applied references, alone or in combination, would not have taught or suggested the claimed method for making up dark skin.

The Office Action admits on page 6 that "Okada et al. do not teach specifically teach [sic] a method for making up dark skin or lightening dark skin." Simon teaches making up skin in general, and is not limited or directed to specifically making up dark skin. In fact, the

Office Action admits on page 7 that "Simon does not teach making up dark skin." The Office Action thus relies on Reinehr for teaching making up dark skin.

Reinehr teaches the use of a polymeric carrier material treated with a fluorescent *whitening agent*, for lightening human skin and for protecting human skin against UV radiation. See abstract and column 1, lines 53-56. Reinehr does not disclose a method for making up dark skin by using the specific claimed combination of a reflective particle together with a coloring agent, wherein "the dark skin has a mean lightness  $L^*$  of less than 55, as measured on a forehead, cheekbones and chin, in a CIE 1976 colorimetric space," as recited by claims 74, 75, 79, 80, 85 and 86. Instead, Reinehr describes that the use of a polymeric carrier material treated with a fluorescent whitening agent allows the degree of whiteness of Reinehr's composition to be increased. See column 17, lines 60-64.

Accordingly, because none of the applied references teach or suggest a method of "making up dark skin," wherein "the dark skin has a mean lightness  $L^*$  of less than 55, as measured on a forehead, cheekbones and chin, in a CIE 1976 colorimetric space," as recited by the claims, the combined teachings of the applied references would not have produced the subject matter of claims 74, 75, 79, 80, 85 and 86.

**C. Conclusion**

For at least these reasons, any combination of the cited references would not have rendered obvious the claimed invention. Accordingly, reconsideration and withdrawal of the rejections are respectfully requested.

**II. Nonstatutory Obviousness-Type Double Patenting**

The Office Action provisionally rejects claims 74, 75, 79-83, 85 and 86 on the ground of non-statutory obviousness-type double patenting over claims 32-34 of co-pending U.S. Patent Application No. 11/172,977. By this Amendment, claims 81-83 are canceled, thereby

rendering their rejection moot. As to the remaining claims, the rejection is respectfully traversed.

Because co-pending application 11/172,977 has not issued, filing a Terminal Disclaimer to obviate a provisional double-patenting rejection is premature. See MPEP §706.02(k). Applicant respectfully requests abeyance of the double patenting rejection. Accordingly, reconsideration and withdrawal of the rejection are respectfully requested.

### **III. Conclusion**

In view of the foregoing, it is respectfully submitted that this application is in condition for allowance. Favorable reconsideration and prompt allowance of the application are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number set forth below.

Respectfully submitted,



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WPB:HHS/kxs

Attachment:  
Petition for Extension of Time

Date: July 17, 2008

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